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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Edward LaVALLIE and Lisa RACIE

Serial No. : 08/848,439 Art Unit: 1642

Filed : May 8, 1997 Examiner: S. Ungar

For : HUMAN SDF-5 PROTEIN AND COMPOSITIONS

September 18, 1998

Hon. Commissioner of
Patents and Trademarks
Washington, DC 20231

CERTIFICATE OF MAILING

I hereby certify that the following paper is being deposited with the United States Postal Service as First Class Mail service pursuant to 37 C.F.R. § 1.8(a) in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231, on Sept. 18 1998

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RESPONSE TO RESTRICTION REQUIREMENT

In response to the Restriction Requirement dated July 20, 1998, Applicants provide the following comments.

The Applicants acknowledge with appreciation the withdrawal of the restriction requirement between Groups I and II. However, the Examiner has maintained the restriction requirement between Groups I and III. The Applicants believe that the restriction requirement is improper, and should be withdrawn. The claims of Group III, which depend from claim 10 should be examined together with the independent claim (Group I), as the subject matter of this group is not distinct. Thus, any search conducted by the Patent Office of any of these three Groups would necessarily involve search of the same subject matter and would result in multiple patent documents each relating to subject matter which is largely duplicative of the others. The public should not be subjected to the burden of examining numerous patent documents in this manner.

The Examiner has required an election between species a (species a of claim 1 and the SEQ. ID NO:2 of claim 2) and species b (SEQ. ID NO:3 of claim 2). Because election is required, Applicants hereby provisionally elect the species of a. However, the restriction requirement is clearly improper, and Applicants hereby traverse same, for the following reasons. These claims each link several species of nucleotide or polypeptide sequences which encode a functional human SDF-5 protein. Under the M.P.E.P.,

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Applicants are permitted to claim a reasonable number of species in a single application. In fact, the Code of Federal Regulations and the M.P.E.P. explicitly state that the presence of a linking generic claim prevents restriction, even if otherwise proper. See 37 C.F.R. §1.141; M.P.E.P. §809.03. The Examiner stated, in the paragraph bridging pages 2 and 3 of the Office Action, that “a review of 37 CFR 1.141 reveals that the rule is drawn to national applications and the instant application is not a national application. . . .” The Applicants respectfully point out that the instant application is a national application, since it was filed in the Patent Office under 35 U.S.C. § 111. See 37 C.F.R. § 1.9(a)(1). Thus, the election of species requirement is improper and should be withdrawn. Applicants request that the Examiner withdraw this requirement.

CONCLUSION

In view of the foregoing election, early examination and allowance of the present application are respectfully solicited.

Respectfully submitted,

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